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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,708	04/13/2001	Helge Knieb	MERCK-2241	4989

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-4

# Office Action Summary

Application No.

09/833,708

Applicant(s)

KNIEB ET AL.

Examiner

Katarzyna Wyrozebski Lee

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 8, 10 and 14 is/are rejected.
- 7) ☐ Claim(s) 2 and 7 is/are objected to.
- 8) ☐ Claim(s) 1-14 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

### DETAILED ACTION

1. Applicant's election with traverse of Group I claims 1-8, 10 and 14 in Paper No. 3 is acknowledged. The traversal is on the ground(s) that the restriction is not proper, since restricted claims depend on independent claim 1. This is not found persuasive because of the following explanation:

The applicant's argued that for the process to be distinguished it must be shown that the method of making composition can be made utilizing different processes. It is examiner's position, that such steps include injection molding, compression molding, coating, wherein coating and molding are two different processes. The applicant does list film-forming resins in claims.

The method of making an article, requires that the article be subjected to the laser beam, wherein the laser beam can be other than Nd:YAG, for example, CO<sub>2</sub>. In addition barcode can be one of many articles formed from the composition.

The requirement is still deemed proper and is therefore made FINAL.

In the light of the fact that restricted claims do depend on the composition claim, therefore they contain all the limitations of the composition. The examiner of record will agree to rejoin the claims once the composition becomes in condition for allowance and upon applicant's request.

### *Claims Analysis*

The present claims are understood by the examiner as those, which require metal powder and /or semimetal powder and special effect pigment. Polymer composition comprising at least powder and special effect pigment, is seen as a composition, which can be laser marked, since the chemical properties of the components are inherent.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-5, 8, 10, 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hawrylko (US 5,496,630).

The Abstract of the prior art of Hawrylko discloses composition comprising polyvinyl chloride thermoplastic matrix, powdered aluminum in an amount of 0.05-4 wt % and titanium dioxide coated mica in the amount of 0.1-50wt % and optionally other organic or inorganic coloring pigments. The article formed in extruded and molded article.

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The example in col. 7 further discloses composition comprising PVC, additives such as acrylic polymer, soy oil, stearic acid, impact modifier and wax, powdered aluminum, Pear titanium coated mica and additional colors such as blue, magenta, red and black.

In the light of the above disclosure, the prior art of Hawrylko anticipates the requirements of claims 1, 3-5, 8, 10 and 14 of the present invention.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawrylko (US 5,496,630) in view of Linzmeier (US 6,521,688).

The discussion of the disclosure of the prior art of Hawrylko from paragraph 3 of this office action is incorporated here by reference.

The difference between the present invention and the disclosure of the Hawrylko is the recitation of the polymeric component in a composition that can be laser marked.

With respect to the above difference, the prior art of Linzmeier discloses laser markable composition comprising coated special effect pigment.

The preferred special effect pigment in the prior art of Linzmeier is mica coated with metal oxide, wherein metal oxide is titanium dioxide (see examples, Minatec 30CM).

Polymers utilized in the composition of Linzmeier include polyethylene, polypropylene and polyesters (col. 3, lines 15-30). Particular examples disclose polyesters (example 6, col. 5), polyamide (example 8, col. 6), polypropylene (example 9, line 6).

The components of the composition are mixed and molded into an article that can be laser marked.

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Titanium dioxide coated mica, it s special effect pigment, which can be utilized in plastic composition, for its pearl-luster effect along with other coloring agents. One of ordinary skill in the art can change the polymeric matrix depending on the intended use of the composition.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art that utilizing other polymeric components, such as polyolefins, polyesters and polyamides, in composition of Hawrylko would still provide decorative articles of Hawrylko, which can be laser marked.

8. Claims 2 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record does not teach use of silicon powder. The prior art of record also does not teach dopant, which further comprises metal halide.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Zimmermann et al (US 5,951,750), Linzmeier et al (US 6,214,917), Pfaff et al (US 6,294,010), Solms et al. (US 2002/0068773), Kniess (US 6,291,551), Elder (US 2002/010305), Knies (US 2001/0021731).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
KIWL  
March 10, 2003